

1 Remarks

2 Claim Objections

3 Claims 1-16 were objected to because the compositions of the aluminum
4 alloys should reflect that the weight percent is used.

5 In response, claims 1-3, 7-9 and 11-13 have been amended to indicate that
6 the percent of alloy is weight percent. The unamended claims do not recite any
7 percent of alloy, and so no amendment is necessary.

8 The Applicants believe that the amendments to claims 1-3, 7-9 and 11-13 fully
9 address the objections to the claims, and therefore request that the objections to the
10 claims now be removed.

11
12 Rejections of claims under 35 USC § 102

13 Claims 1-2 and 11-12 have been rejected as being anticipated by Brasse
14 (U.S. Pat. 3,732,083); claims 1-3 and 11-13 have been rejected as being anticipated
15 by Slater (U.S. Pat. 3,300,838); claims 1-4, 6, 11-14 and 16 have been rejected as
16 being anticipated by Lynch (U.S. Pat. 2,539,248); claims 1-4 and 11-14 have been
17 rejected as being anticipated by Ramos (WO 96/11800); and claims 1-4 and 11-14
18 have been rejected as being anticipated by Wyatt (U.S. Pat. 2,747,256).

19 Claims 1 and 11 are independent claims. Accordingly, if the Applicants can
20 demonstrate that claims 1 and 11 are patentable, then those claims which depend
21 therefrom should also be allowed.

22 It is well established that "[a]nticipation requires that all of the elements and
23 limitations of the claims are found within a single prior art reference." (Scripps Clinic
24 and Research Found. v Genetech. Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001,
25 1010 (Fed. Cir. 1991 (emphasis added))). Moreover, the PTO and the Federal Circuit
provide that §102 anticipation requires that there must be no difference between the

1 claimed invention and the reference disclosure. (Scripps Clinic and Research Found.
2 v. Genetech, Inc., id. (emphasis added)).

3 Accordingly, if the Applicants can demonstrate that any one element or
4 limitation in claims 1 and 11 is not disclosed by Brasse, Slater, Lynch, Ramos or
5 Wyatt, then the respective claim(s) must be allowed.

6 Claims 1 and 11 have been amended to include the limitation that “the second
7 member consisting essentially of Al and between about 1.8 wt.% to 10.0 wt.% Si”.
8 Support for this amendment is found in the specification at page 4 lines 12-13. This
9 limitation precludes the addition of other alloys (in any significant amount) to the
10 second member. As described throughout the specification, this limitation is
11 particularly useful for transition inserts since it maintains the electrical conductivity
12 and weldability of the second member, resistance to cracking, and a relatively high
13 melting point of the second member. However, in each of Brasse, Slater, Lynch,
14 Ramos and Wyatt, the described aluminum components include other alloys beyond
15 silicon. Specifically: Brasse at col. 2 lines 50-53 states, “the aluminum based
16 bearing alloy composition contains, as the essential alloying elements, from about
17 3.5% to about 4.5% tin ... from about 0.7% to about 4.5% copper”; Slater at col. 2
18 lines 30-32 states, “the aluminum alloy should consist essentially of5 to 4%
19 cadmium”; Lynch at col. 2 lines 14-21 describes that the aluminum used typically
20 includes “cadmium up to 5%”, or “6.5% tin ... 1% copper [and] 0.5% nickel”;
21 Ramos at page 3 line 28 states that, “the aluminum alloy comprises from 3 to 30% of
22 tin; and Wyatt at col. 1 lines 48-53 states that, “the [aluminum] alloy may also contain
23 up to 18% by weight of tin, ... up to 1% of iron, up to 2 ½% of magnesium, up to 2%
24 of cadmium, up to 2% of lead, and up to 2% of zinc” It should be noted that
25 Brasse, Slater, Lynch, Ramos and Wyatt are all directed towards producing
compounds for bearing surfaces. The considerations for producing bearing surfaces
are considerably different than the considerations for producing transition inserts

(which are recited at length in Applicants' specification). Specifically, maintaining electrical conductivity and a relatively high melting point in the aluminum alloy are not relevant to bearing surfaces, whereas such considerations are relevant to transition inserts.

Accordingly, since claims 1 and 11 (and inherently, those claims which depend therefrom) now recited a limitation neither taught nor suggested by the cited references, the references cannot anticipate claims 1-6 and 11-16. The Applicants therefore request that the rejections of claims 1-4, 6, 11-14 and 16 be removed and the claims allowed.

Rejections of claims under 35 USC § 103

Claims 6 and 16 have been rejected as being obvious in light of Ramos (WO 96/11800).

Claim 6 depends from claim 1, and claim 16 depends from claim 11. For the reasons stated above, the Applicants contend that claims 1 and 11 (as amended) are allowable. As stated in MPEP 2143.03, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." As claims 1 and 11 (as amended) are nonobvious, then claims 6 and 16 (which depend respectively therefrom) are also nonobvious, and are thus allowable. The Applicants therefore request that the rejections of claims 6 and 16 be removed and the claims allowed.

Claims 1-16 have been rejected as being obvious over Lynch (U.S. Pat. 2,539,248) in view of Szecket (U.S. Pat. 4,842,182).

Claims 1, 7 and 11 are independent claims. Accordingly, if claims 1, 7 and 11 are allowable (i.e., nonobvious), then the claims which depend therefrom are also nonobvious and allowable.

1 As set forth in MPEP 2143, "To establish a prima facie case of obviousness,
2 three basic criteria must be met. First, there must be some suggestion or motivation,
3 either in the references themselves or in the knowledge generally available to one of
4 ordinary skill in the art, to modify the reference or to combine reference teachings.
5 Second, there must be a reasonable expectation of success. Finally, the prior art
6 reference (or references when combined) must teach or suggest all the claim
7 limitations. The teaching or suggestion to make the claimed combination and the
8 reasonable expectation of success must both be found in the prior art, not in
9 applicant's disclosure." (Emphasis added.)

10 The Applicants contend that claims 1, 7 and 11 are nonobvious over Lynch in
11 view of Szecket since those claims, as amended, include a limitation not taught or
12 suggested by the references. Specifically, claims 1, 7 and 11 now include the
13 limitation that "the second member consisting essentially of Al and between about
14 1.8 wt.% to 10.0 wt.% Si".

15 As described above, Lynch does not teach or suggest this limitation, as Lynch
16 describes at col. 2 lines 14-21 that the aluminum used typically includes "cadmium
17 up to 5%", or "6.5% tin ... 1% copper [and] 0.5% nickel" Szecket does not cure
18 the deficiency of Lynch. Specifically, Szecket only describes a method of bonding
19 metals and their alloys, including "aluminum ... and their respective alloys" (col. 3
20 lines 24-29 and the table in Fig. 27). Any combination of Lynch and Szecket only
21 results in using the aluminum alloy described by Lynch (which contains cadmium, or
22 tin, copper and nickel) in the process of Szecket. That is, neither reference teaches
23 or suggests using a second member in a bonded assembly with a first member
24 wherein "the second member consist[s] essentially of Al and between about 1.8 wt.%
25 to 10.0 wt.% Si".

For at least this reason the Applicants contend that independent claims 1, 7
and 11 (as amended), and the claims that depend therefrom, are not obvious over

1 Lynch in view of Szecket. The Applicants therefore request that the rejections of
2 claims 1-16 under 35 USC 103 be removed and the claims allowed.

3
4 Request for Extension of time under 37 CFR § 1.136(a)

5 Applicants hereby request a three (3) month extension of time under 37 CFR
6 § 1.136(a) to respond to the Office action of March 24, 2005, to and through
7 September 26, 2005. It being noted that September 24, 2005 was a Saturday, under
8 37 CFR § 1.7, the Applicants are given until Monday, September 26, 2005 to file the
9 response under the three month extension.

10 The required fee is enclosed herewith.

11
12 Summary

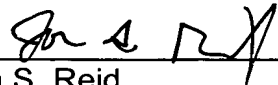
13 The Applicants believe this is a full and complete response to the Office action
14 mailed March 24, 2005. The Applicants further believe that claims 1-16 are
15 allowable, and therefore request timely allowance of those claims.

16 The Examiner is respectfully requested to contact the below-signed attorney if
17 the Examiner believes this will facilitate prosecution toward allowance of the claims.

18
19 Respectfully submitted,

20 Steven W. Ping and Rick James

21 Date: September 26, 2005

22 By 
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